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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,170	04/28/2000	Mark D. Levitt	103-1345.00	3695

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EXAMINER

AHMED, SHEEBA

ART UNIT PAPER NUMBER

1773

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/560,170

Applicant(s)

LEVITT ET AL.

Examiner

Sheeba Ahmed

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 28-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 20-27 and 39-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 17, 2003 (Paper No. 18) has been entered.

Response to Amendment

2. Amendments to claims 20, 27, and, 41 have been entered in the above-identified application. New claims 47-51 have been added. **Claims 1-51 are now pending with claims 20-27 and 39-51 now under consideration.**

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 41-46 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

Art Unit: 1773

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 41 and dependent claim 49 now recite that the strippable laminate finish kit comprises "a strip agent-permeable polymerizable topcoat comprising water and at least about 15 wt.% solids" however there is no support for such an amendment in the original disclosure. Page 8, lines 16-20 of the Specification state that kit contains the topcoat that could be packaged as concentrates intended to be "mixed with water or another suitable solvent at about a 15 to 40% solids level" and as pointed out by the Applicants, Formulations A and B in Table 3 on Page 14 allow for the formulation to contain about 47% solids. Hence, there is no support for a topcoat having more than 47% solids and the phrase "at least 15 wt.% solids" includes compositions comprising more than about 47 wt. % solids. Appropriate correction or clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 22-24, 27, 39, 41-45, and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1).

Hamrock et al. disclose a floor finishing system (***corresponding to the strippable laminate finish kit of the claimed invention***) comprising a radiation curable composition and a primer composition (***corresponding to the intermediate coating of the claimed invention***) wherein the primer composition is coatable over a substrate and the radiation curable composition (***corresponding to the topcoat of the claimed invention***) is coatable thereon (Page 6, lines 25-30). The radiation curable coating comprises a polyfunctional isocyanurate and a hydroxyalkyl acrylate (Page 4, lines 21-30). A preferred monomer is shown on Page 5 and contains an aromatic group (***thus meeting the limitations that the topcoat composition comprises an acrylated urethane or an aromatic urethane***). The cured, coatable composition is readily strippable from the substrate when the latex primer is present (Page 7, lines 1-3).

Hamrock et al. do not specifically teach that the radiation curable coating (*i.e., the coating corresponding to the top of the claimed invention*) is water borne or that it comprises water.

However, Holman et al. disclose a method of finishing floors wherein the floor may be coated with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents (Column 2, lines 1, lines 5-6 and Column 2, lines 3-5). Examples of the polymers include aliphatic urethanes, urethane/acrylic polymers and acrylic polymers and these polymers/copolymers are designed for high performance uses, where hardness, flexibility, UV resistance, chemical resistance and abrasion resistance are desired. One specific example of the urethane/acrylic copolymer is a

Art Unit: 1773

high solids, radiation curable, water-borne formulation by the trade name of NEORAD 3709 (Column 4, lines 11-36). Preferably, the coating compositions have a solids content of 30-70 wt.% based on the total weight of the composition (Column 4, lines 1-5).

Accordingly, it would have been obvious to one having ordinary skill in the art to replace the radiation curable coating comprising a polyfunctional isocyanurate and a hydroxyalkyl acrylate, as taught by Hamrock et al., with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents given that Holman et al. specifically teach that such water-borne coatings exhibit high hardness, flexibility, UV resistance, chemical resistance and abrasion resistance. With regards to the limitation that the polymerized topcoat can be at least partially stripped from the tile in 30 minutes and that the intermediate coating has a stripability rating of 6 or more on a 7 point scale and that the topcoat has a stripability of 4 on a 7 point scale, the Examiner takes the position that such limitations must be met by the coatings taught by Hamrock and Holman given that the chemical composition of these coating and that of the claimed invention are identical.

5. Claims 26, 40, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and Lake (US 5,571,570).

Hamrock et al. and Holman et al., as discussed above, do not teach that the topcoat composition is an aliphatic polyester urethane.

However, Lake discloses a UV curable topcoat composition that exhibits superior flexibility, durability, thermal stability, crack resistance, chemical resistance, stain resistance and weather resistance and comprises a blend of an acrylated aliphatic polyester urethane (Column 2, lines 28-38 and Claim 9).

Accordingly, it would have been obvious to one having ordinary skill in the art to replace the topcoat composition disclosed by Hamrock et al. and Holman et al. with the composition disclosed by Lake given that Lake teach that their composition exhibits superior flexibility, durability, thermal stability, crack resistance, chemical resistance, stain resistance and weather resistance.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and Koreltz et al. (WO 94/22965).

Hamrock et al. and Holman et al., as discussed above, do not teach that the floor finishing system (***corresponding to the strippable laminate finish kit of the claimed invention***) further comprises a strip agent.

However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system

Art Unit: 1773

disclosed by Hamrock et al. given that such compositions can be used to remove multiple coatings comprising urethane/acrylic polymers.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and Scarlette (US 6,399,689 B1).

Hamrock et al. and Holman et al., as discussed above, do not teach that the topcoat composition is an aromatic urethane.

However, Scarlette discloses a UV curable coating comprising an acrylic or urethane resin (Column 2, lines 3-17) and wherein the coating maybe used as a floor finishing composition for providing coatings with enhanced abrasion resistance without comprising other functionally significant properties such as flexibility, hardness and adhesion (Column 3, lines 37-42). Examples 1 shows that the resin may be an acrylated aromatic urethane.

Accordingly, it would have been obvious to one having ordinary skill in the art to replace the topcoat composition disclosed by Hamrock et al. with the composition disclosed by Scarlette given that Scarlette specifically teach that the coatings maybe used as a floor finishing composition for providing coatings with enhanced abrasion resistance without comprising other functionally significant properties such as flexibility, hardness and adhesion.

Response to Arguments

8. Applicant's arguments filed on June 17, 2003 have been fully considered but they are not persuasive.

Applicants traverse the rejection of independent claims 20, 27, and 41 under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and submit that Hamrock et al. teach away from topcoats made using available finishes that are waterborne or that comprise water. Applicants further state that there is no motivation for a person of ordinary skill to combine these references.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art to replace the radiation curable coating comprising a polyfunctional isocyanurate and a hydroxyalkyl acrylate, as taught by Hamrock et al., with a water based finish including urethane and acrylic polymers and copolymers and crosslinking agents given that Holman et al. specifically teach that such water-borne coatings exhibit high hardness, flexibility, UV resistance, chemical resistance and abrasion resistance. Furthermore, the Examiner disagrees that

Art Unit: 1773


Hamrock et al. teach away from topcoats made using available finishes that are waterborne or that comprise water given that the proposed modification does not render the prior art invention being modified unsatisfactory for its intended purpose.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703)305-0594. The examiner can normally be reached on Mondays and Thursdays from 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703)308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-5665.


Sheeba Ahmed
Art Unit 1773
September 29, 2003